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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1943.

No. 204

MEAD JOHNSON & COMPANY,
Petitioner,

vs.

HILLMAN'S, INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

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THE TWENTIETH CENTURY PRESS, INC., CHICAGO

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PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Now comes Mead Johnson & Company, petitioner here and plaintiff-appellant below, and respectfully petitions this Honorable Court to grant a writ of Certiorari to the Circuit Court of Appeals for the Seventh Circuit to review a judgment of that Court affirming a decree of the District Court of the United States for the Northern District of Illinois, Eastern Division.

A certified transcript of the record in the case, including the proceedings in the Seventh Circuit Court of Appeals, is furnished herewith.

Summary and Short Statement of the Matter Involved.

This action was brought for infringement of Johnson et al. Patent No. 1,990,329 on a dry, pre-cooked cereal product suitable for infant feeding. The District Court found the patent invalid and dismissed the complaint for

want of equity. The Circuit Court of Appeals for the Seventh Circuit affirmed this decree.

This petition is directed to a review of the decision of the Circuit Court of Appeals for the Seventh Circuit.

Jurisdiction.

This is a suit arising under the patent laws of the United States, Judicial Code, Section 24 (7) (28 U. S. C. A. 41 (7)).

The jurisdiction of this Court is invoked under Section 24 (a) of the judicial code, as amended by the act of February 13, 1925 (28 U. S. C. A. 347).

The date of the decree which petitioner asks to have reviewed is May 21, 1943 (Rec. 484). The petition for rehearing was denied July 6, 1943 (Rec. 487).

The Questions Presented.

1. Whether the Circuit Court of Appeals for the Seventh Circuit, in disregarding an unobvious advantage because it was not functionally described in the claims, has adopted a rule of law inconsistent with the law as laid down by this Court, and in direct conflict with the rule of law followed by certain other Circuit Courts of Appeal.

2. Whether, giving proper consideration to the unobvious advantage disregarded by the Circuit Court of Appeals for the Seventh Circuit, Johnson et al. Patent 1,990,329 in suit is valid.

Reasons Relied on for Allowance of Writ.

The discretionary power of this Court to grant a Writ of Certiorari is invoked upon the following grounds:

1. That the Circuit Court of Appeals for the Seventh Circuit, in its decision, set forth and followed a rule of law

in conflict with the law as enunciated by this Court.[1]

2. That the Circuit Court of Appeals for the Seventh Circuit, in its decision, enunciated a rule of law in direct conflict with the law as followed by other circuits, and more particularly the First,[2] Third,[3] and Sixth[4] Circuits, so that there is now a conflict of law between the Seventh Circuit and said First, Third, and Sixth Circuits.

3. That the Circuit Court of Appeals for the Seventh Circuit, by reason of giving no effect to an important and unobvious advantage of the product as an infant's food, because of such court's erroneous rule of law that an advantage is to be disregarded unless described in the claims, wrongly held the Johnson *et al.* patent in suit invalid when said patent represents a great advance in the art of infant feeding and, in fact and law, is valid.

Wherefore, it is respectfully submitted that this petition for a Writ of Certiorari to the Circuit Court of Appeals for the Seventh Circuit should be granted.

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[1] *Diamond Rubber Co.* v. *Consolidated Tire Co.* (1911), 220 U. S. 428, 436, 437.

[2] *I. T. S. Rubber Co.* v. *Panther Rubber Mfg. Co.* (C. C. A. 1, 1919), 260 F. 934, 937.

[3] *Gear* v. *Fairmount Electric Co.* (C. C. A. 3, 1916), 231 F. 728, 732; *Mead-Morrison Mfg. Co.* v. *Exeter Mach. Works* (C. C. A. 3, 1915), 225 F. 489, 496.

[4] *Jackson Fence Co.* v. *Peerless Wire Fence Co.* (C. C. A. 6, 1915), 228 F. 691, 696.

Summary of Argument.

In its opinion in this case, the Seventh Circuit Court of Appeals has laid down the rule of law that an advantage not described in the claims of a patent is to be disregarded. This is in conflict with the law as announced by this Court and as explicitly stated in at least three of the other circuits..... 9

This Court has set forth the law to be that an advantage is to be considered if it results from a combination of characteristics set forth in the claims, whether or not the advantage is set forth in the claims..... 9

The same rule has been explicitly stated by the First, Third and Sixth Circuit Courts of Appeal..... 10

Claims of the patent in suit properly define a combination of matter by describing its physical characteristics 12